

REMARKS

In the Office Action mailed September 20, 2007 (hereinafter, "Office Action"), the Examiner rejected claims 2, 8, 9, 11, 16, and 17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,275,824 to O'Flaherty et al. (hereinafter, "*O'Flaherty*") in view of U.S. Patent No. 5,930,391 to Kinjo et al. (hereinafter, "*Kinjo*") and U.S. Patent No. 7,181,438 to Szabo (hereinafter, "*Szabo*").

By this response, Applicant hereby amends claims 2, 8, 9, 11, 16, and 17. Claims 1, 3-7, 10, and 12-15 were previously canceled. No new matter has been added. Accordingly, claims 2, 8, 9, 11, 16, and 17 remain pending.

Based on the foregoing amendments and the following remarks, Applicant respectfully traverses the rejection of claims under 35 U.S.C. § 103(a), and requests allowance of the pending claims.

I. Information Disclosure Statement

In the Office Action, the Examiner states that "[t]he information disclosure statement filed 9/7/2007 . . . fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of relevance . . . [and] the information referred to therein has not been considered." Office Action, p. 2. The Examiner further indicates that this is because "each patent listed . . . is not in the English language." *Id.* However, Applicant disagrees and, for the reasons contained below, submits that the **Examiner is required by 37 C.F.R. §§ 1.97 and 1.98 and M.P.E.P. § 609 to consider the following documents** cited on Form PTO/SB/08 and referenced in the Information Disclosure Statement filed on August 7, 2007 (hereinafter, "*IDS*"):

- Japanese Patent Publication No. 2002-73995;
- Japanese Patent Publication No. 2001-167201; and
- Japanese Patent Publication No. 6-83847.

An information disclosure statement shall be considered by the Office if filed by the applicant before the mailing of a first Office action on the merits. 37 C.F.R. § 1.97(b)(3); M.P.E.P. § 609. Where the information listed is not in the English language, but was cited in a search report or other actions by a foreign patent office in a counterpart foreign application, **the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. M.P.E.P. § 609(III)** (emphasis added). Once the minimum requirements of 37 C.F.R. §§ 1.97 and 1.98 are met, the examiner has an **obligation** to consider the information. *Id.*

The previously filed *IDS* citing Japanese Patent Publication Nos. 2002-73995, 2001-167201, and 6-83847 was in full compliance with 37 C.F.R. §§ 1.97 and 1.98. Specifically, **the requirement under 37 C.F.R. § 1.98(a)(3)(ii) for a concise explanation of relevance was met because the *IDS* was filed along with the English language translation of the Notification of Reasons for Rejection** issued by the Japanese Patent Office, dated June 26, 2007, for corresponding Japanese Patent Application No. 2002-307576. For the Examiner's convenience, Applicant has included copies of the Notice of Reasons for Rejection from the Japanese Patent Office, the English-language translation of the Notice of Reasons for Rejection, the *IDS*, and the PTO/SB/08 submitted to the U.S. Patent and Trademark Office on August 7, 2007.

The *IDS* states that “[i]n lieu of a statement of relevance or translation of the non-English documents, Applicant provides a Notification of Reasons for Rejection . . . [and] an English-language translation of the Notification” *IDS*, pp. 1-2. **Japanese Patent Publication Nos. 2002-73995, 2001-167201, and 6-83847 are discussed on pages 2 and 3 of the English-language translation of the Notification.**

Therefore, Applicant has **clearly met the requirements** outlined in the M.P.E.P. and **the Examiner is required to consider** Japanese Patent Publication No. 2002-73995, Japanese Patent Publication No. 2001-167201, and Japanese Patent Publication No. 6-83847.

II. Claim Rejection Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 2, 8, 9, 11, 16, and 17 under 35 U.S.C. § 103(a) as being unpatentable over the cited art because a *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103(a) is the clear articulation of the reasons why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See M.P.E.P. § 2141, 8th Ed., Rev. 6 (Sept. 2007). “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III) (internal citations omitted). In addition, when “determining the differences between the prior art

and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (internal citations omitted) (emphasis in original).

In this application, a *prima facie* case of obviousness has not been established because, among other things, the cited references, taken alone or in combination, do not teach or suggest each and every feature of Applicant’s claims. Specifically, Applicant respectfully submits that claims 2, 8, 9, 11, 16, and 17 are allowable because neither *O’Flaherty*, nor *Kinjo*, nor *Szabo*, taken alone or in any combination, teaches or suggests, *inter alia*, “an authentication unit configured to execute personal authentication by using the authentication information, and obtain, if the authentication information is authentic, two pass IDs whose values are the same,” “a first generation unit configured to generate a temporary ID when the pass ID is equal to another of the two pass IDs,” and “a second storing unit configured to store the anonymous information item to which the temporary ID and one of a plurality of levels which corresponds to the personal information item are added, and the encrypted personal information item, and the anonymous information item . . . ,” as recited in amended independent claim 2. Amended independent claim 11, which has a scope different from that of claim 2, should be allowable for similar reasons.

A. *O’Flaherty*

O’Flaherty fails to teach or suggest, *inter alia*, “an authentication unit configured to execute personal authentication by using the authentication information, and obtain, if the authentication information is authentic, two pass IDs whose values are the same,” “a

first generation unit configured to generate a temporary ID when the pass ID is equal to another of the two pass IDs,” and “a second storing unit configured to store the anonymous information item to which the temporary ID and one of a plurality of levels which corresponds to the personal information item are added, and the encrypted personal information item, and the anonymous information item . . . ,” as recited in amended independent claim 2.

Instead, *O’Flaherty* discloses an apparatus “having a database management system 104 storing one or more extended databases 106.” *O’Flaherty*, col. 4, ll. 4-5. “Virtually all access to the data stored in the extended database 106 is provided solely through [a] dataview.” *Id.* at col. 4, ll. 37-38 (emphasis added). *O’Flaherty* states that the dataview is formed when the “database management system . . . define[s] a virtual table and save[s] that definition in the database as metadata with a user-defined name.” *Id.* at col. 4, ll. 8-11 (emphasis added). Thus, *O’Flaherty* fails to disclose or suggest “an authentication unit configured to execute personal authentication by using the authentication information, and obtain, if the authentication information is authentic, two pass IDs whose values are the same” and “a first generation unit configured to generate a temporary ID when the pass ID is equal to another of the two pass IDs,” as recited in amended independent claim 2.

In addition, *O’Flaherty* fails to teach or suggest, *inter alia*, “a second storing unit configured to store the anonymous information item to which the temporary ID and one of a plurality of levels which corresponds to the personal information item are added, and the encrypted personal information item, and the anonymous information item . . . ,” as also recited in claim 2. Instead, *O’Flaherty* explicitly states that “[m]etadata about the

privacy dataviews (including the dataview name, names and data types of the dataview columns, and the method by which the rows are to be derived) is stored persistently in the databases metadata, but the actual data presented by the view is not physically stored anywhere in association with the derived table.” *O’Flaherty*, col. 4, ll. 18-25 (emphasis added). Indeed, “[a]s a virtual table, a dataview is not physically materialized anywhere in the database until it is needed.” *Id.* at col. 4, ll. 14-15.

Accordingly, neither *O’Flaherty*, nor any obvious variant thereof, teaches or suggests the recitations of amended independent claim 2. Therefore, the rejection of claim 2 under 35 U.S.C. § 103(a) should be withdrawn, and the claim allowed. Claims 8 and 9 should also be allowable due to their dependence from amended independent claim 2.

Independent claim 11, although of different scope, recites subject matter similar to that of claim 2. For at least the same reasons as set forth above in connection with amended independent claim 2, *O’Flaherty* cannot support a rejection of claim 11 under 35 U.S.C. § 103(a). Therefore, the rejection of claim 11 under 35 U.S.C. § 103(a) should be withdrawn, and the claim allowed. Claims 16 and 17 should also be allowable due to their dependence from independent claim 11.

B. *O’Flaherty* and *Kinjo*

Kinjo fails to cure the deficiencies set forth above and the failure of *O’Flaherty* to teach or suggest, *inter alia*, “an authentication unit configured to execute personal authentication by using the authentication information, and obtain, if the authentication information is authentic, two pass IDs whose values are the same,” “a first generation unit configured to generate a temporary ID when the pass ID is equal to another of the

two pass IDs,” and “a second storing unit configured to store the anonymous information item to which the temporary ID and one of a plurality of levels which corresponds to the personal information item are added, and the encrypted personal information item, and the anonymous information item . . . ,” as recited in amended independent claim 2.

The Examiner appears to rely on “Kinjo [to disclose an] **image of a person**, as the person’s face image” (emphasis in original) and “to extract a contour of the person’s face, to detect the image of the person’s face.” Office Action, page 5. *If Kinjo* includes such a teaching, which Applicant does not concede, it does not remedy the aforementioned deficiencies of *O’Flaherty*.

Instead, *Kinjo* teaches a “photographic printing apparatus” for “edge tracing processing for extracting a human contour” in which “contours of face candidate regions which are assumed to correspond to person’s faces are judged from among the plurality of contour lines which were extracted by the . . . edge tracing processing for extracting a human contour.” *Kinjo*, col. 11, l. 66, col. 16, ll. 61-62, and col. 16, l. 65 - col. 17, l. 2.

Further, *Kinjo* fails to teach or suggest “a second storing unit configured to store the anonymous information item to which the temporary ID and one of a plurality of levels which corresponds to the personal information item are added, and the encrypted personal information item, and the anonymous information item . . . ,” as recited in claim 2. Instead, *Kinjo* teaches “the image which is positioned at the exposure position is printed onto the photographic printing paper 28 at the exposure amounts E_j .” *Id.* at col. 22, ll. 4-7.

In addition to the failure of *O'Flaherty* and *Kinjo* to teach or suggest all the claim limitations, either alone or in combination, the Examiner's stated motivation is neither suggested by the references themselves nor in the knowledge generally available to one of ordinary skill in the art. Further, *O'Flaherty* and *Kinjo* disclose alleged inventions intended for entirely different purposes and it would not have been obvious to one of ordinary skill in the art to combine the references. As mentioned above, *O'Flaherty* discloses a system for database management, whereas *Kinjo* discloses a method for image processing.

The Examiner's assertion at pages 4-5 of the Office Action that "[i]t would have been obvious to a person with ordinary skill in the art . . . to modify the teachings of *O'Flaherty* with the teachings of *Kinjo* to utilize the contour of person's image in the data privacy management system with the motivation to enhance obtaining accurate information with correct contour line regions . . . , " misrepresents the teachings of both *O'Flaherty* and *Kinjo*. *O'Flaherty* teaches "[a] method, apparatus, and article of manufacture for managing data privacy." *O'Flaherty*, Abstract. However, *Kinjo* discloses "a method of determining copy conditions" in which "the area corresponding to the extracted outer edge region is subject to appropriate processing depending on the characteristics of the extracted region." *Kinjo*, Abstract, col. 1, ll. 18-19. A schema such as taught by *Kinjo* would not be subject to combination with the system and method of *O'Flaherty* and it is unclear how a motivation to combine the two very divergent disclosures can be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Therefore, it would not have been

obvious to use the image processing scheme taught by *Kinjo* database management scheme disclosed by *O'Flaherty*.

Accordingly, neither *O'Flaherty*, nor *Kinjo*, taken individually or together, teaches or suggests the recitations of amended independent claim 2. Therefore, the rejection of claim 2 under 35 U.S.C. § 103(a) should be withdrawn, and the claim allowed. Claims 8 and 9 should also be allowable due to their dependence from independent claim 2.

Independent claim 11, although of different scope, recites subject matter similar to that of claim 2. For at least the same reasons as set forth above in connection with amended independent claim 2, the cited references cannot support a rejection of claim 11 under 35 U.S.C. § 103(a). Therefore, the rejection of claim 11 under 35 U.S.C. § 103(a) should be withdrawn, and the claim allowed. Claims 16 and 17 should also be allowable due to their dependence from independent claim 11.

C. *O'Flaherty, Kinjo, and Szabo*

Szabo fails to cure the deficiencies set forth above and the failure of *O'Flaherty* and *Kinjo* to teach or suggest, *inter alia*, "an authentication unit configured to execute personal authentication by using the authentication information, and obtain, if the authentication information is authentic, two pass IDs whose values are the same," "a first generation unit configured to generate a temporary ID when the pass ID is equal to another of the two pass IDs," and "a second storing unit configured to store the anonymous information item to which the temporary ID and one of a plurality of levels which corresponds to the personal information item are added, and the encrypted

personal information item, and the anonymous information item . . . ,” as recited in amended independent claim 2.

The Examiner relies on *Szabo* to disclose “including (a) a first access level which is assigned to a first group of users of the users who can access only the anonymous information item out of the anonymous information item and the personal information item and (b) a second access level which is assigned to a second group of users of the users who can access both of the anonymous information item and the personal information item.” Office Action, p. 2. Even if that were correct, which Applicant does not concede, *Szabo* still fails to disclose or suggest the recitations discussed above.

Instead, *Szabo* discloses methods for “structuring hierarchal organizational sets of information, providing an interactive search definition and ranking process, improved formatting of presented information, as well as use of applets to define and extend functionality of computer systems.” *Szabo*, col. 28, ll. 5-9. “According to [*Szabo*], a set of information may be transmitted from the server to the client, for presentation to the user.” *Id.* at col. 29, ll. 43-45. “The information may be classified according to the ultimate taxonomy, regardless of the level of analysis employed by the user, or may be classified only to a lesser level of granularity, for example a level specified by the user or adaptively determined based on the user query, user profile, and the information content retrieved.” *Id.* at col. 29, ll. 45-50.

Accordingly, neither *O’Flaherty*, nor *Kinjo*, nor *Szabo*, taken individually or together, teaches or suggests the recitations of amended independent claim 2. Therefore, the rejection of claim 2 under 35 U.S.C. § 103(a) should be withdrawn, and

the claim allowed. Claims 8 and 9 should also be allowable due to their dependence from independent claim 2.

Independent claim 11, although of different scope, recites subject matter similar to that of claim 2. For at least the same reasons as set forth above in connection with amended independent claim 2, the cited references cannot support a rejection of claim 11 under 35 U.S.C. § 103(a). Therefore, the rejection of claim 11 under 35 U.S.C. § 103(a) should be withdrawn, and the claim allowed. Claims 16 and 17 should also be allowable due to their dependence from independent claim 11.

III. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application, and the timely allowance of the pending claims.

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: December 20, 2007

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Attachments:

- Information Disclosure Statement filed August 7, 2007;
- PTO/SB/08 filed August 7, 2007;
- Notification of Reasons for Rejection from the Japanese Patent Office mailed June 26, 2007; and
- English-language translation of Notification of Reasons for Rejection from the Japanese Patent Office mailed June 26, 2007.